

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

VINCENT J. GATTO ET AL.)
)
APPLN NO.: 10/788,850) GROUP ART UNIT: 1625
)
CONFIRMATION NO.: 6851)
)
FILED: FEBRUARY 27, 2004) EXAMINER: TAYLOR V. OH
)
HYDROXYPHENYLCARBOXYLIC)
ACID ESTERS)

Customer Number: 65895

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION FOR REVISION OF PATENT TERM ADJUSTMENT

Sir:

This petition is submitted in the above case for reconsideration of the Patent Term Adjustment indicated in the patent under 37 C.F.R. §1.705(d). This petition is being filed within two months of the date the patent issued. The above case issued as U.S. Patent No. 7,667,066 on February 23, 2010. It is submitted that this petition complies with the requirements of 37 C.F.R. §1.705(b)(1) and §1.705(b)(2).

Payment of the fee for this petition under 37 C.F.R. §1.18(e), as required by 37 C.F.R. §1.705(b)(1), is submitted herewith.

The requirements of 37 C.F.R. §1.705(b)(2) are set forth on the following pages.

CERTIFICATE OF SUBMISSION

I hereby certify that, in the course of ordinary business, this paper (along with any referred to as being attached or enclosed) is being submitted to the United States Patent and Trademark Office via EFS-Web on the date indicated below.

April 23, 2010
Date

/Mary H. Drabnis/
Mary H. Drabnis

STATEMENT OF FACTS

The statement of the facts involved as required under 37 C.F.R. §1.705(b)(2):

- (i) The correct patent term adjustment is believed to be 1977 days, 1608 days greater than the number indicated on the patent, 369 days.

The bases for the adjustment are §1.702(a)(1) and §§1.702(b) and (b)(1).

- (ii) The relevant dates as specified in §§1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in §1.703(f) to which the patent is entitled:

Under §1.703(a)(1), the relevant dates are April 27, 2005, 14 months from the filing date, and September 28, 2006, the date of mailing of the first Office Action by the USPTO, a total of 519 days. We note that this was credited to Applicant in the Patent Term Adjustment calculation made by the USPTO.

Under §1.703(b), the relevant dates are February 28, 2007, the day after the date that is three years after the filing date, and February 23, 2010, the issue date of the patent.

Under §1.703(b)(1), the first relevant date is March 12, 2008, when a request for continued examination was filed. What qualifies as the relevant second date depends on whether the example set forth in the Federal Register (69 Fed. Reg. 34284, June 21, 2004) which indicates that the end of the period subtracted from the post-three year earned days is the date of mailing of a Notice of Allowance, or whether §1.703(b)(1) is interpreted as stated therein, meaning that the end of the period subtracted from the post-three year earned days is the issue date of the patent.

If the end of the period subtracted under §1.703(b)(1) is as indicated in the Federal Register, the second relevant date is October 13, 2009, the date of mailing of the Notice of Allowance. Under this interpretation, the patent term adjustment is as set

forth above, 1977 days, 1608 days greater than the number indicated on the patent.

If §1.703(b)(1) is interpreted as stated therein, the second relevant date is February 23, 2010, the date the patent issued. Under this interpretation, the patent term adjustment is 1844 days, 1475 days greater than the number indicated on the patent.

The adjustment as specified in §1.703(f) to which the patent is entitled will run from the expiration date of the patent as set forth in 35 U.S.C. §154(a)(2). The expiration date of the patent under 35 U.S.C. §154(a)(2) is February 27, 2024. Under the handling of the RCE as stopping the subtraction at the mailing of a Notice of Allowance, an additional 1977 days will cause the patent to expire on July 27, 2029. If §1.703(b)(1) is interpreted such that the RCE stops the subtraction when the patent issues, an additional 1844 days will cause the patent to expire on March 16, 2029.

For the record, there is no overlap of "A" and "B" delays as described in the *Wyeth* decision in this case.

- (iii) This patent is not subject to a terminal disclaimer.
- (iv) Circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704:

Two requests for continued examination (RCE) were filed, one on March 12, 2008, as described above, and one on April 27, 2009. Both of these RCEs were filed more than three months after the date of mailing of the respective Office Actions to which they responded, a delay under §1.704(b). Delays for these filings were subtracted in the Patent Term Adjustment calculation made by the USPTO.

For the RCE filed on April 27, 2009, Applicants were incorrectly over-penalized for their delay (90 days, when it should have been 65 days). However, it is understood

that any issues that could have been raised in an application for patent term adjustment filed no later than the payment of the issue fee (such as this issue) will not be considered in a petition under §1.705(d).

Another delay occurred via an informal amendment that was submitted with a timely-filed response to an Office Action; the correction (a proper amendment) was filed 12 days later. This is a delay under §1.704(c).

Favorable action is solicited on this petition because it fulfills the requirements of 37 C.F.R. §1.705(b)(1) and (b)(2), as stipulated in 37 C.F.R. §1.705(d), and thus is submitted to be a grantable petition.

If any matters remain that require further consideration, the Office is requested to telephone the undersigned at the number given below so that such matters may be discussed, and if possible, promptly resolved.

Please continue to address all correspondence in this Application to Albemarle Corporation at the address of record.

Respectfully submitted,

/Mary H. Drabnis/

Mary H. Drabnis
Reg. No. 45,909
McGlinchey Stafford, PLLC
301 Main Street, 14th Floor
Baton Rouge, LA 70802
Telephone: 225-382-3718
Facsimile: 225-343-3076